

PATENT IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
(Attorney Case No. 02-793-C)

In re Application of:

John, et al.

Serial No.: 10/658,959

Filed: September 10, 2003

For: Acetyl 2-Hydroxy-1,3-Diaminoalkanes

Before the Examiner:
Zinna Northington Davis

Art Unit: 1625

PETITION TO WITHDRAWAL FROM ISSUE UNDER 37 C.F.R. § 1.313(c)(1)

Office of Petitions
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Pursuant to 37 C.F.R. § 1.313(c)(1), Applicants petition to have the above-identified application withdrawn from issue.

The issue fee was paid on June 5, 2006. It is not known when this application will issue as a Patent; no Issue Notification has been received, and there is no indication of an issue date on the PAIR system.

The reason applicant seeks withdrawal from issue of this application is because claim 12 is unpatentable.

Amendments to claim 12 are identified on page 2, where claim 12 is listed.

Remarks begin on page 6.

The Commissioner is hereby authorized to charge the \$130 petition fee under 37 C.F.R. § 1.17 (h) to Deposit Account No. 13-2490 in the name of McDonnell Boehnen Hulbert & Berghoff LLP. The Commissioner is also authorized to charge any additional fees or credit any overpayment, to Account No. 13-2490.

Adjustment date: 10/12/2006 CKHLOK
10/11/2006 INTEFSW 00000263 132490 10658959
01 FC:1808 130.00 CR

10/12/2006 CKHLOK 00000001 132490 10658959

01 FC:1464 130.00 DA

12. (Currently Amended) A compound according to claim 1 which is
- N-((1S,2R)-1-(3,5-difluorobenzyl)-2-hydroxy-3-(((4R)-6-isopropyl-2,2-dioxido-3,4-dihydro-1H-isothiochromen-4-yl)amino)propyl)acetamide;
- N-((1S,2R)-1-(3,5-difluorobenzyl)-2-hydroxy-3-(((4S)-6-isopropyl-2,2-dioxido-3,4-dihydro-1H-isothiochromen-4-yl)amino)propyl)acetamide;
- N-((1S,2R)-1-(3,5-difluorobenzyl)-3-((6-ethyl-2,2-dioxido-3,4-dihydro-1H-isothiochromen-4-yl)amino)-2-hydroxypropyl)acetamide;
- ~~N-((1S,2R)-1-(3,5-difluorobenzyl)-3-((6-ethyl-2,2-dioxido-3,4-dihydro-1H-isothiochromen-4-yl)amino)-2-hydroxypropyl)acetamide;~~
- N-((1S,2R)-1-(3,5-difluorobenzyl)-3-((2,2-dioxido-3,4-dihydro-1H-isothiochromen-4-yl)amino)-2-hydroxypropyl)acetamide;
- N-[1-(3,5-Difluoro-benzyl)-3-(6-ethyl-2,2-dioxo-2 λ^6 -isothiochroman-4-ylamino)-2-hydroxy-propyl]-2-methylamino-acetamide;
- 2-Amino-N-[1-(3,5-difluoro-benzyl)-3-(6-ethyl-2,2-dioxo-2 λ^6 -isothiochroman-4-ylamino)-2-hydroxy-propyl]-acetamide;
- N-((1S,2R)-1-(3,5-difluorobenzyl)-3-((6-ethyl-2-(methylsulfonyl)-1,2,3,4-tetrahydroisoquinolin-4-yl)amino)-2-hydroxypropyl)acetamide;
- N-[1-(3,5-Difluoro-benzyl)-3-(6-ethyl-2,2-dioxo-2 λ^6 -isothiochroman-4-ylamino)-2-hydroxy-propyl]-3-methyl-butyramide;
- N-[1-(3,5-Difluoro-benzyl)-3-(6-ethyl-2,2-dioxo-2 λ^6 -isothiochroman-4-ylamino)-2-hydroxy-propyl]-3-hydroxy-2,2-dimethyl-propionamide;
- N-((1S,2R)-1-(3,5-difluorobenzyl)-3-((2,2-dioxido-3,4-dihydro-1,2-benzoxathiin-4-yl)amino)-2-hydroxypropyl)acetamide;
- N-((1S,2R)-1-(3,5-difluorobenzyl)-2-hydroxy-3-((6-iodo-3,4-dihydro-2H-chromen-4-yl)amino)propyl)acetamide;
- N-((1S,2R)-1-(3,5-difluorobenzyl)-2-hydroxy-3-(((4S)-6-iodo-3,4-dihydro-2H-chromen-4-yl)amino)propyl)acetamide;
- N-((1S,2R)-1-(3,5-difluorobenzyl)-2-hydroxy-3-(((4R)-6-iodo-3,4-dihydro-2H-chromen-4-yl)amino)propyl)acetamide;
- N-[1-(3,5-Difluoro-benzyl)-3-(6-ethyl-2,2-dioxo-2 λ^6 -isothiochroman-4-ylamino)-2-hydroxy-propyl]-3-hydroxy-propionamide;

N-((1S,2R)-1-(3,5-difluorobenzyl)-3-[(6-ethyl-2,2-dioxido-3,4-dihydro-1,2-benzoxathiin-4-yl)amino]-2-hydroxypropyl)acetamide;

~~N-((1S,2R)-1-(3,5-difluorobenzyl)-3-[(6-ethyl-2,2-dioxido-3,4-dihydro-1,2-benzoxathiin-4-yl)amino]-2-hydroxypropyl)acetamide;~~

N-((1S,2R)-1-(3,5-difluorobenzyl)-3-[[4-(3-ethylphenyl)tetrahydro-2H-pyran-4-yl]amino]-2-hydroxypropyl)acetamide;

N-((1S,2R)-1-(3,5-difluorobenzyl)-3-[[4S]-6-ethyl-3,4-dihydro-2H-chromen-4-yl]amino)-2-hydroxypropyl)acetamide;

N-((1S,2R)-1-(3,5-difluorobenzyl)-3-[[4R]-6-ethyl-3,4-dihydro-2H-chromen-4-yl]amino)-2-hydroxypropyl)acetamide;

N-[1-(3,5-Difluoro-benzyl)-3-(6-ethyl-2,2-dioxo-2 λ^6 -isothiochroman-4-ylamino)-2-hydroxy-propyl]-3-hydroxy-butyramide;

N-((1S,2R)-1-(3,5-difluorobenzyl)-3-[(6-ethyl-3,4-dihydro-1H-isothiochromen-4-yl)amino]-2-hydroxypropyl)acetamide;

~~N-((1S,2R)-1-(3,5-difluorobenzyl)-2-hydroxy-3-[[1-(3-isobutylisoxazol-5-yl)cyclopropyl]amino]-propyl)acetamide;~~

N-[1-(3,5-Difluoro-benzyl)-3-(6-ethyl-2,2-dioxo-2 λ^6 -isothiochroman-4-ylamino)-2-hydroxy-propyl]-2-phenyl-acetamide;

{[1-(3,5-Difluoro-benzyl)-3-(6-ethyl-2,2-dioxo-2 λ^6 -isothiochroman-4-ylamino)-2-hydroxy-propylcarbamoyl]-methyl}-methyl-carbamic acid tert-butyl ester;

N-[1-(3,5-Difluoro-benzyl)-3-(6-ethyl-2,2-dioxo-2 λ^6 -isothiochroman-4-ylamino)-2-hydroxy-propyl]-2-methyl-2-methylamino-propionamide;

N-((1S,2R)-1-(3,5-difluorobenzyl)-3-[(6-ethyl-2,2-dioxido-3,4-dihydro-1H-2,1-benzothiazin-4-yl)amino]-2-hydroxypropyl)acetamide;

N-((1S,2R)-1-(3,5-difluorobenzyl)-3-[(6-ethyl-2,2-dioxido-3,4-dihydro-1H-2,1-benzothiazin-4-yl)amino]-2-hydroxypropyl)acetamide;

N-((1S,2R)-1-(3,5-difluorobenzyl)-3-[(6-ethyl-3-methyl-2,2-dioxido-3,4-dihydro-1H-isothiochromen-4-yl)amino]-2-hydroxypropyl)acetamide;

N-((1S,2R)-1-(3,5-difluorobenzyl)-3-[(6-ethyl-3-methyl-2,2-dioxido-3,4-dihydro-1H-isothiochromen-4-yl)amino]-2-hydroxypropyl)acetamide;

N-((1S,2R)-1-(3,5-difluorobenzyl)-3-[(6-ethyl-1-methyl-1,2,3,4-tetrahydroquinolin-4-yl)amino]-2-hydroxypropyl)acetamide;

N-[1-(3,5-Difluoro-benzyl)-3-(6-ethyl-2,2-dioxo-2 λ^6 -isothiochroman-4-ylamino)-2-hydroxy-propyl]-2-(1H-imidazol-4-yl)-acetamide;

N-[1-(3,5-Difluoro-benzyl)-3-(6-ethyl-2,2-dioxo-2 λ^6 -isothiochroman-4-ylamino)-2-hydroxy-propyl]-propionamide;

N-((1S,2R)-1-(3,5-difluorobenzyl)-3-[[1-(4-ethylpyridin-2-yl)cyclopropyl]amino]-2-hydroxypropyl)acetamide;

N-((1S,2R)-1-(3,5-difluorobenzyl)-2-hydroxy-3-[[[(4S)-6-(1H-pyrrol-3-yl)-3,4-dihydro-2H-chromen-4-yl]amino]propyl]acetamide;

N-((1S,2R)-1-(3,5-difluorobenzyl)-2-hydroxy-3-[(6-isopropyl-3,4-dihydro-2H-chromen-4-yl)amino]propyl)acetamide;

~~N-((1S,2R)-1-(3,5-difluorobenzyl)-3-[[1-(3-ethylphenyl)-2-(5-methyl-1,3-oxazol-2-yl)ethyl]amino]-2-hydroxypropyl)acetamide hydrochloride~~

N-[(1S,2R)-1-(3,5-difluorobenzyl)-3-(3,4-dihydro-2H-chromen-4-ylamino)-2-hydroxypropyl]acetamide;

N-((1S,2R)-1-(3,5-difluorobenzyl)-2-hydroxy-3-[[[(4S)-6-isobutyl-3,4-dihydro-2H-chromen-4-yl]amino]propyl]acetamide;

N-[(1S,2R)-3-[[[(4S)-6-cyano-3,4-dihydro-2H-chromen-4-yl]amino]-1-(3,5-difluorobenzyl)-2-hydroxypropyl]acetamide;

N-((1S,2R)-1-(3,5-difluorobenzyl)-2-hydroxy-3-[[[(4S)-6-neopentyl-3,4-dihydro-2H-chromen-4-yl]amino]propyl]acetamide;

N-((1S,2R)-1-(3,5-difluorobenzyl)-2-hydroxy-3-[(6-neopentyl-3,4-dihydro-2H-chromen-4-yl)amino]propyl)acetamide;

N-((1S,2R)-1-(3,5-difluorobenzyl)-3-[[[(4R)-6-(2,2-dimethylpropyl)-3,4-dihydro-2H-chromen-4-yl]amino]-2-hydroxypropyl]acetamide;

N-[(1S,2R)-3-[[4-(3-tert-butylphenyl)tetrahydro-2H-pyran-4-yl]amino]-1-(3,5-difluorobenzyl)-2-hydroxypropyl]acetamide;

N-((1S,2R)-1-(3,5-difluorobenzyl)-3-[[6-(2,2-dimethylpropyl)-1,2,3,4-tetrahydroquinolin-4-yl]amino]-2-hydroxypropyl)acetamide;

N-[(1S,2R)-3-[[[(4S)-6-(2,2-dimethylpropyl)-3,4-dihydro-2H-chromen-4-

yl]amino}-1-(3-fluorobenzyl)-2-hydroxypropyl]acetamide;

~~N-((1S,2R)-1-(3,5-difluorobenzyl)-3-[[5-(2,2-dimethylpropyl)-2-(1H-imidazol-1-yl)benzyl]amino]-2-hydroxypropyl)acetamide;~~

N-((1S,2R)-1-(3,5-difluorobenzyl)-3-[[6-(2,2-dimethylpropyl)-4-methyl-3,4-dihydro-2H-chromen-4-yl]amino]-2-hydroxypropyl)acetamide;

~~N-((1S,2R)-1-(3,5-difluorobenzyl)-2-hydroxy-3-((1-[3-(3-thienyl)phenyl]cyclohexyl)amino)propyl)acetamide;~~

~~N-((1S,2R)-1-(3,5-difluorobenzyl)-3-((1-[4-(2,2-dimethylpropyl)pyridin-2-yl]cyclopropyl)amino)-2-hydroxypropyl)acetamide;~~

or a pharmaceutically acceptable salt thereof.

Remarks

Claim 12 as allowed is unpatentable because it did not fully comply with the requirements of 35 U.S.C. § 112, Second Paragraph. In particular, as allowed, claim 12 encompasses compounds not within the scope of claim 1, the independent claim from which it depends. Specifically, claim 12 included compounds having an alkyl spacer between the variable R_C and the core, while such compounds are not encompassed by claim 1 as it was amended during prosecution. Consequently, claim 12 has been amended herein by removing the compounds that have an alkyl spacer between the variable R_C and the core. Claim 12 now properly depends from claim 1, and claim 12 is now patentable.

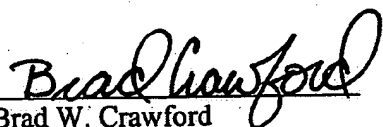
In addition, the following compounds were each named twice in claim 12: N-((1S,2R)-1-(3,5-difluorobenzyl)-3-[(6-ethyl-2,2-dioxido-3,4-dihydro-1H-isothiochromen-4-yl)amino]-2-hydroxypropyl}acetamide and N-((1S,2R)-1-(3,5-difluorobenzyl)-3-[(6-ethyl-2,2-dioxido-3,4-dihydro-1,2-benzoxathiin-4-yl)amino]-2-hydroxypropyl}. The second occurrence of each name was removed.

No new matter was added by the above amendments.

Respectfully submitted,

**McDonnell Boehnen
Hulbert & Berghoff LLP**

Dated: October 10, 2006

By: 
Brad W. Crawford
Reg. No. 50,494

McDonnell Boehnen
Hulbert & Berghoff LLP
300 S. Wacker Drive
Chicago, Illinois 60606
Tel. No. (312) 913-2114
Customer Number 20306